

REMARKS

This Amendment is being filed along with a Request for Continued Examination (RCE) to place the application in condition for allowance. By this Amendment, Applicants amend claims 157, 163, 174, and 180. Accordingly, claims 1-180 are pending in this application. No new matter is added by this Reply.

Applicants gratefully acknowledge the Examiner's allowance of claims 1-156 in the Final Office Action dated September 1, 2005. Applicants further appreciate the Examiner's indication that rejected claims 157-162 would be allowable if rewritten to overcome the Examiner's § 112 rejections, and that claims 171-174, 178, and 179 would be allowable if rewritten to overcome the Examiner's § 112 rejections and to include all of the limitations of the base claim and any intervening claims. In the Final Office Action, the Examiner rejected claims 157-168, 174, and 180 under 35 U.S.C. § 112, second paragraph; rejected claims 163-168, and 180 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,829,504 to Chen; and rejected claims 169, 170, and 175-177 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,231,516 to Keilman.

At the outset, Applicants thank the Examiner for conducting an interview with Applicants' representatives on January 17, 2006. During the interview, Applicants agreed to file an RCE and this accompanying Amendment, to amend claims 157, 163, 174, and 180 to overcome the pending § 112 rejections. Moreover, Applicants agreed to provide arguments to traverse the § 102(e) and § 103(a) rejections set forth in the Final Office Action.

In the Final Office Action, the Examiner rejected claims 157-168, 174, and 180 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly

point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Examiner indicated that “[i]n claims 157, 163, and 180, the stimulation device should be recited as being ‘adapted to be implanted’ in order to avoid inadvertently claiming the patient’s body.” (Office Action at 2.) By this Amendment, Applicants amend claims 157, 163, and 180 to include “adapted to be implanted,” thereby rendering the Examiner’s § 112 rejection of those claims moot. Accordingly, Applicants request that the Examiner withdraw the rejection of claims 157, 163, and 180. Applicants also assert that the Examiner’s § 112 rejection of claims 158-162 and 164-168 are also moot, due at least to their dependence from amended claims 157 and 163, respectively, and request that the Examiner withdraw the § 112 rejection of those claims as well. The Examiner further indicated that “[i]n claim 174, the pulse generator lacks clear antecedent basis.” (Office Action at 2.) By this Amendment, Applicants amend claim 174 to depend from claim 171, thereby rendering the Examiner’s § 112 rejection of claim 174 moot. Accordingly, Applicants request that the Examiner withdraw the rejection of claim 174. Applicants point out that claims 157-162 were only rejected based on the above § 112 rejections, and therefore, claims 157-162 are allowable as amended.

In the Final Office Action, the Examiner also rejected claims 163-168 and 180 under 35 U.S.C. § 102(e) as being anticipated by Chen. Applicants respectfully traverse these rejections. The Examiner asserts that Chen discloses “a pulse generator 640, a conductive housing 658, sensing circuitry 670 and electrodes 607, 608 connected to leads 602, 604,” (Office Action at 2) in support of the § 102(e) rejections. The Examiner further contends, however, that the “pulse generator of the above claims

[163-168 and 180] being implanted in a blood vessel is considered to be intended use not supported by structure [and, therefore, does not limit claim scope.]” (Id. at 3.) . Applicants disagree. Amended claim 163 recites “a pulse generator, adapted to be implanted within a blood vessel,” while amended claim 180 recites “an implantable stimulation device, adapted to be implanted within a blood vessel.” (Emphasis added.) The phrase “adapted to be implanted” defines structural attributes of the claimed implantable stimulation device and distinguishes Chen. Unlike the implantable stimulator device disclosed in Chen, the claimed implantable stimulator device has sufficient structure to be adapted to be implanted within a blood vessel. Support for this structural limitation may be found, for example, at page 30, line 17 - page 31, line 10.

Not only is the “adapted to be implanted” limitation structural, but it has weight and limits the scope of claims 163 and 180. Both the MPEP and the case law support this assertion. For example, the last paragraph of MPEP § 2173.05(g) cites In re Venezia for the proposition that “limitations such as ‘members adapted to be positioned’...serve to precisely define present structural attributes of interrelated component parts of the claimed assembly.” See In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). Similarly, here, “adapted to be implanted” provides a structural limitation to amended claims 163 and 180. Thus, because Chen fails to disclose “a pulse generator” or “an implantable stimulation device” that is “adapted to be implanted within a blood vessel,” as recited in amended claims 163 and 180, these claims cannot be anticipated by Chen. Therefore, Applicants respectfully request that the Examiner withdraw the rejections of claims 163 and 180. Applicants further request

withdrawal of the rejections of dependent claims 164-168, due at least to their dependence from allowable claim 163.

In the Final Office Action, the Examiner also rejected claims 169, 170, and 175-177 under 35 U.S.C. § 103(a) as being unpatentable over Keilman. Applicants respectfully traverse these rejections. The Examiner contends that the “stimulation device called for in...claims [169, 170, and 175-177] is considered to be encompassed by the ultrasonic and drug capabilities provided in the device of Keilman.” (Office Action at 3.) Applicants disagree. The Examiner’s contention clearly ignores the preamble of claim 169, for example, which recites “[a] method of implanting a stimulation device for electrically stimulating a patient’s heart.” (Emphasis added.) Applicants contend that the stimulation device recited in claim 169 provides electrical stimulation to a patient’s heart. Applicants draw the Examiner’s attention to MPEP § 2111.02, which states that “[a]ny terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.” Moreover, MPEP § 2111.02 further provides that “clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention.” Accordingly, because Keilman does not teach or suggest providing electrical stimulation to a patient’s heart, Keilman cannot render claim 169 obvious under 35 U.S.C. § 103(a). Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claim 169. Applicants further request withdrawal of the rejections of dependent claims 170 and 175-77, due at least to their dependence from allowable claim 169.

In view of the above amendments, Applicants assert that the entire application is now in condition for allowance. A timely notice of allowance is earnestly requested.

The Examiner is invited to telephone the undersigned at (202) 408-4387, should the Examiner foresee any impediment to allowance.

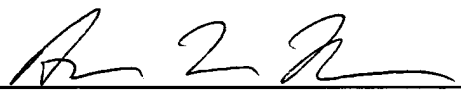
The Final Office Action may contain statements or characterizations with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Final Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 1, 2006

By: 
Aaron L. Parker
Reg. No. 50,785